



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/107,979 06/30/98 GODOWSKI

P P1084R1-2

EXAMINER

LEE, L

ART UNIT

PAPER NUMBER

1645

DATE MAILED:

01/25/01

GENENTECH INC  
ATTN: DEIRDRE L CONLEY  
1 DNA WAY  
SOUTH SAN FRANCISCO CA 94080

HM22/0125

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

File Copy

# **Advisory Action**

Application No.

09/107,979

Applicant(s)

Godowaki et al

Examiner

LI Lee

Group Art Unit

1645

THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☐ expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on \_\_\_\_\_ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Dec 26, 2000 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☒ The proposed amendment(s):
- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
- ☒ will not be entered because:
- ☒ they raise new issues that would require further consideration and/or search. (See note below).
- ☐ they raise the issue of new matter. (See note below).
- ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: see the attachment.

- ☐ Applicant's response has overcome the following rejection(s):

- ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

- ☐ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: 30 and 42

Claims objected to: \_\_\_\_\_

Claims rejected: 31, 32, 39-41, 43, and 44

- ☐ The proposed drawing correction filed on \_\_\_\_\_ ☐ has ☐ has not been approved by the Examiner.

- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

- ☐ Other

Art Unit: 1645

### **Advisory Action**

1. Applicant's amendment response to the final rejection, filed on Dec 26, 2000 has been considered and will not be entered for the reasons set forth in the previous Office actions and below:
2. The new limitations in the proposed claims raise new issues that would require further consideration and new literature and sequence comparison searches, e.g., the new limitations in claim 39, "wherein the polypeptide is encoded by a nucleic acid sequence comprising nucleic acids 1150 to and including 1290 of the NRG3 nucleic acid open reading frame sequence SEQ ID NO:1", in claim 40, "wherein the polypeptide is encoded by a nucleic acid sequence comprising nucleic acids 999 to and including 1139 of the NRG3 nucleic acid open reading frame sequence SEQ ID NO:5", in claim 41, "wherein the polypeptide is encoded by a nucleic acid sequence comprising nucleic acids 856 to and including 996 of the NRG3 nucleic acid open reading frame sequence SEQ ID NO:22", in claim 43, "wherein the polypeptide has at least one native amino acid glycosylation site substituted or deleted", and in claim 44, "wherein the polypeptide is glycosylated with a ratio of sugars that differs from native glycosylation". These new limitations have not been previously considered and they require new sequence and literature search and further consideration. Applicant's arguments that are drawn to the rejections of the claims under 35 U.S.C. 112, Second Paragraph and under 35 U.S.C. 112, First Paragraph as amended are moot in view of the non-entry of the proposed amendment.

Art Unit: 1645

Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1645 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Li Lee whose telephone number is (703) 308-8891. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached at (703) 308-3909.

Li Lee  
January 18, 2001

  
LYNETTE R. F. SMITH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600